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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,743	09/06/2000	Alice H. Howe	MPH 99-46	9068

7590

02/21/2002

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EXAMINER

CHIU, RALEIGH W

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 02/21/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/655,743

Applicant(s)

HOWE, ALICE H.

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-7, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldi or Musslin and either in view of Melbye and applicant's admission of the prior in his specification.

Regarding the amendment to claims 1 and 10, the Feldi racquet as applied above would inherently permit the fastener material to make tangential contact with a tennis ball because it has been admitted that SCOTCHMATE products perform as recited.

3. Claims 8, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldi, Musslin, Melbye and applicant's admission of the prior art in his specification as applied above in view of Urwin as applied in the previous Office action.

### *Response to Arguments*

4. Applicant's arguments filed 30 November 2001 have been fully considered but they are not persuasive.

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Regarding the affidavit, item 10 states that it is factually incorrect to conclude that Melbye, at column 1, lines 15-23, discloses VELCRO and SCOTCHMATE are functional equivalents as hook-and-loop fasteners or that equivalency may be extended to cover the uniquely different pre-shrunk nylon monofilament hooks of the highly specific and narrowly defined characteristics as defined by the currently amended claims. The affidavit is unpersuasive because it is not directed to the aspects on which reliance is made.

Although the Melbye claims are directed to a mushroom-type hook strip, Melbye is relied upon, in the instant application, for his showing that VELCRO and SCOTCHMATE are functional equivalents as hook-and-loop fasteners.

In response to applicant's page 7 remarks that the "Office action relies upon a mistaken assumption that any and all commercially available fasteners are equivalent to each other", it is noted that it is the prior art itself which acknowledges that hook-and-loop fasteners are "currently marketed under the trademark VELCRO by Velcro USA, Inc., and under the trademark SCOTCHMATE by 3M, Co.".

Feldi clearly teaches that VELCRO can be used in combination with tennis racquets to pick up tennis balls. In fact, Feldi explicitly discloses in the first three lines of the

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Abstract that his device uses two "components of the VELCRO or **any** brand hook and loop fastening system" (emphasis added).

Given Melbye's teaching (column 1, lines 15-18) that SCOTCHMATE is a known hook and loop fastening system, it would have been obvious to one of ordinary skill in the art to substitute a SCOTCHMATE fastener for the VELCRO one.

In his Remarks on page 9, applicant notes that he has "discovered a limited and narrowly defined 'preshrunk monofilament hooks' of highly specific characteristics [which] are effective without completely changing the tennis ball pile". However, it is noted that the claims do not preclude changing the tennis ball pile and the Feldi racquet itself, as modified above, would inherently function as recited.

Applicant's Remarks on pages 9, 10 and 13 regarding the cupped contact of Urwin are not on point. Applicant's attention is directed to page 4 of the previous Office action which explicitly states that Urwin is relied upon for his teaching on column 4, lines 8-13 that hook and loop fasteners can be placed anywhere along the outer surface of the racquet frame.

#### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Raleigh W. Chiu  
Primary Examiner  
Technology Center 3700

RWC:dei:feif  
21 February 2002